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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MULCAHY, PETER D

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 09/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/834,606

Applicant(s)

TANAKA, YOSHIMICHI

Examiner

Peter D. Mulcahy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2&3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7 are rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for a fender formulated from a specific composition as both described and exemplified in the specification it, does not reasonably provide enablement for a fender which is limited only by the properties as set forth in the claim. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The claimed fender is limited only by the properties of the rubber composition from which the fender is formed. Applicants' claims recite "a rubber composition" and provide no compositional ingredients or amounts. The Examiner maintains that a degree of undue experimentation would be necessary so as to determine whether or not a fender formulated from a composition would fall within the metes and bounds of the instantly claimed invention. The claims are seen as being single means claims wherein the claim covers every conceivable means for achieving the stated

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properties. As such, the patentability is solely dependent upon these properties and the claim is not commensurate in scope with the enabling disclosure of the specification which sets out specific compositions which fall within the scope of the claims. The Courts have well established that single means claims are properly rejectable under 35 U.S.C. § 112 first paragraph following In re Hyatt 218 USPQ 195.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) The invention was described in (1) an application for patent, published under Section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 102(b) or (e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tajima et al., U.S. Patent 6,187,420 or Hashimoto, U.S. Patent 6,103,808 or Dailey, U.S. Patent 6,393,655 or Nakahira, U.S. Patent 4,530,386 each taken alone and in the alternative.

The Tajima patent clearly shows marine fender articles which are formulated from rubber compositions which appear to anticipate those as described in the specification. See specifically Table 1 at columns 7 and 8.

The Hashimoto patent shows rubber compositions which have various applications wherein a fender is clearly contemplated. See specifically the Abstract. This patent further shows compositions which appear to anticipate or render obvious applicants' compositions as described and exemplified within the specification. See specifically column 8 line 53 - column 9 line 50.

The Dailey patent also shows rubber compositions which find applications in a wide variety of rubber products. A marine

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fender application is set forth at column 5 lines 39+. The composition as described throughout columns 7-11 appears to anticipate or render obvious that as shown within the specification.

The Nakahira patent contemplates the use of compositions for the formulation of a fender for use on a ship side at column 5 lines 1+. The composition as described in columns 6-8 as well as exemplified in Example 12 anticipates the compositions as described and claimed within applicants' instant specification.

It is acknowledged by the Examiner that none of the patents cited specifically disclose each of the properties as claimed in the claims. The Examiner maintains however that the patents show compositions which anticipate those within the specification and one of ordinary skill in the art would reasonably expect the compositions of the prior art to possess properties which either anticipate or render obvious applicants' instantly claimed properties. A rejection under 35 U.S.C. § 102 or 103 is proper when the reference discloses all the limitations of a claim except a property or function and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has a basis for shifting the burden of proof to applicants. See In re Fitzgerald, 619 F. 2d 67, 205 USPQ 594 (CCPA 1980).

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The claims are further rendered obvious by the prior art in that there is a recitation of each of the ingredients in the prior art and the prior art teaches mixing the ingredients so as to formulate compositions which would form fenders having the properties as claimed. A review of the specification shows that there are no unexpected results within the specifically claimed composition. Applicants appear to have manipulated properties by mixing different ingredients in different amounts. It is prima facie obvious to optimize properties by manipulating the ingredients and the amounts. See In re Reese 129 USPQ 402 where it is clearly stated that it is prima facie obvious to one of ordinary skill in the art to arrive at optimum proportions of ingredients by obvious experimentation.

It is further prima facie obvious to combine known compounds and have them function in an expected manner. See In re Lintner, 173 USPQ 356.

Applicants should identify the compositional difference between the instantly claimed invention and the prior art cited.

Applicants should note that there appears to be an incomplete sentence at page 31 lines 8 and 9 of the specification.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter D. Mulcahy, whose telephone number is (703) 308-2449. The examiner can normally be reached on Tuesday through Friday from 7:30 A.M. to 6:00 P.M.

The fax telephone number for this group is (703) 872-9306.

Any inquiry of general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2351.

P. Mulcahy:cdc
September 3, 2003



PETER D. MULCAHY
PRIMARY EXAMINER